

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/921,060 Confirmation No.: 6179
Applicant : Marty Steinberg
Filed : August 2, 2001
Title : Method and System for Management of Purchasing Incentives
TC/Art Unit : 3688
Examiner: : D. Champagne
Docket No. : 99997.023404
Customer No. : **21967**

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Commissioner for Patents
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Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to the Pre-Appeal Brief Conference Program, Applicant hereby requests a pre-appeal brief conference in the above-referenced application. The following responds to the Office Action of June 2, 2008 ("Office Action") regarding claims 1, 2, 5-18, and 21-27. A Notice of Appeal is attached.

Claims 1, 2, 5-18, and 21-27 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,061,660 issued to Eggleston et al. ("Eggleston"). Applicant respectfully disagrees for all of the reasons set forth in the previous responses filed December 4, 2006, August 6, 2007, and February 29, 2008, and for at least the following additional reasons. Applicant respectfully submits the Office Action's allegation that Eggleston renders the claims obvious is unreasonable at least because Eggleston does not teach or suggest (1) receiving information regarding a consumer's existing memberships in one or more loyalty programs, (2) receiving a query from a consumer for a specific product or service available through the consumer's membership in one or more loyalty programs and transmitting information identifying available purchasing incentives, and (3) verifying that an existing membership is valid, as recited in various forms in independent claims 1, 16, 22, and 23.

I. Eggleston does not teach or suggest receiving information regarding a consumer's existing memberships in one or more loyalty programs.

Independent claims 1, 16, 22, and 23 each recite a similar step of receiving information regarding a consumer's *existing* memberships in one or more loyalty programs. For example, claim 1 was amended during prosecution to recite:

receiving from a plurality of consumers information regarding each consumer's *existing* memberships in one or more loyalty programs, *wherein each consumer previously enrolled in the one or more loyalty programs prior to the information for that respective consumer being received and each consumer's previous enrollment is distinct from receiving the membership information for that respective consumer*, the membership information comprising the name of the offering company or organization for each loyalty program in which the consumer has a membership and identification information sufficient to identify each existing membership;

Eggleston is directed to a contest-format system whereby consumers register with a host system in order to participate in "incentive programs" to "win" awards or prizes from sponsors, and then collect the awards or prizes from retailers. The invention of Eggleston is "an inventive program and award fulfillment system that provides easy access to consumers who have standard computer hardware and software, that permits sponsors to build or purchase incentive programs easily and efficiently, and that provides for convenient tracking of participation and convenient, automated award fulfillment." Col. 5, lines 38-44. The entities involved in the system are "a host who manages the system, one or more consumers who participate in incentive programs and in certain instances win awards, one or more sponsors who offer incentive programs through the host system, and one or more retailers who provide awards for the incentive programs and who fulfill delivery of awards to consumers." Col. 10, lines 3-9.

Figure 8 of Eggleston shows the interaction of a consumer with the host system to win prizes through the incentive programs. A consumer first registers to become a member of the host system and is assigned a personal identification number and password to access the host system. Col. 12, lines 22-30. The consumer can then "participate in one or more incentive programs" through the host system website. Col. 13, lines 43-45; col. 16, lines 19-24. "Participation in the incentive programs could include entering data, completing surveys, clicking on one or more icons in a predetermined manner, or other 'win eligible' activities, such as answering questions." Col. 13, lines 45-51. The incentive programs may be provided by the host system itself or by a sponsor through the host system. Col. 12, lines 45-48. When the consumer wins an incentive program, a "win" message is triggered and the consumer is informed of the appropriate prize. Col. 13, lines 51-54; col. 21, lines 30-31 ("a prize is awarded upon successful completion of an incentive program"); col. 40, lines 36-37. The prize could be "retail merchandise, . . . loyalty points, discounts, coupons and the like," and may be redeemed through various retailers associated with the host system. Col. 13, lines 56-58; col. 43, lines 37-48. In essence, the Eggleston system is designed to entice a consumer to register to thereby provide marketing information about himself or herself and win a prize for providing such information.

It has nothing at all to do with analyzing and assessing which of multiple loyalty programs that a person already belongs to offers purchasing incentives for a specific product or service.

Thus, Eggleston only teaches a consumer registering to become a member of the host system and then, after registering, selecting an incentive program in which to “participate.” The fact that a consumer may “revisit” the host system website by entering his or her identification number and password, as the Office Action seems to suggest, does not mean that the host system receives information regarding the consumer’s *existing* memberships in loyalty programs. *See* Office Action at 2. Rather, the only information received from a consumer is registration information *for the host system* (not for any incentive program), which occurs *before* the consumer is allowed to participate in an incentive program on the host system website. Col. 13, lines 10-13 (registration information includes name, address, phone number, etc.); col. 4, lines 6-9; Fig. 17. The consumer does not enroll in loyalty programs beforehand and then provide “identification information sufficient to identify each existing membership,” as recited in the claims. Indeed, the consumer name and password cited in the Office Action as “identification information” actually pertain to the host system as a whole, not to any particular loyalty program, and are therefore insufficient to identify membership in a loyalty program, as recited in the claims. *See* Office Action at 2.

The Office Action acknowledges that Eggleston “does not teach that information regarding the consumer’s existing memberships in one or more loyalty programs is received from a plurality of consumers,” but asserts that “[b]ecause it would be advantageous to have as many participating offering companies/sponsors as possible in the sponsor database 202, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that consumers be invited to *recommend sponsors* to the sponsor database 202, which would read on receiving from a plurality of consumers information regarding the consumer’s existing memberships in one or more loyalty programs.” *See* Office Action at 4 (emphasis added). The system disclosed in Eggleston, however, would not work if a consumer could merely “recommend” a sponsor to the host system. The incentive programs in Eggleston, which include “scratch-and-win games, sweepstakes games, treasure hunt games, or computer games,” require an “algorithm for determining a winner.” Col. 13, lines 45-47; col. 35, lines 21-22. The sponsor creates an incentive program in conjunction with the host system by purchasing a “pre-packaged” incentive program or building an incentive program from scratch and then selecting the prizes for the program. Col. 14, lines 26-67. If a consumer could merely recommend a sponsor in Eggleston, there would be no way for the host system to know the algorithm to determine a winner or the prizes that may be won. Without such information, a consumer could not “participate” in any incentive program, as defined in Eggleston. There is therefore a clear deficiency in the rejections stated in the Office Action.

The Office Action also gave no patentable weight under MPEP § 2106.01 to the limitations that “each consumer previously enrolled in the one or more loyalty programs prior to the information for that respective consumer being received and each consumer’s previous enrollment is distinct from receiving the membership information for that respective consumer.” *See* Office Action at 3. The added limitations are functional, however, because they amount to a positive recitation of the claim term “existing memberships” and properly define the scope of the

term in relation to the receiving step. Specifically, a consumer must have previously enrolled in a loyalty program in order for information about that “existing” membership to be received. The limitation that the consumer’s previous enrollment is “distinct” from receiving membership information for that consumer also defines the scope of the positive receiving step. Accordingly, independent claims 1, 16, 22, and 23, as well as claims 2, 5-6, 8-11, 14, 15, 17, 18, 21, and 24-27 which depend from the independent claims, are not obvious in view of Eggleston.

II. Eggleston does not teach or suggest receiving a query from a consumer for a specific product or service available through the consumer’s membership in one or more loyalty programs and transmitting information identifying available purchasing incentives.

Independent claims 1, 16, 22, and 23 also recite in various forms “receiving a query from one of the consumers comprising a request to identify purchasing incentives *for a specific product or service available through the one or more loyalty programs in which the consumer has a membership*” and “transmitting to the consumer information identifying purchasing incentives available through the one or more loyalty programs in which the consumer is a member *for the specific product or service.*” As previously explained, and without limitation, a consumer who is a member of the AARP and also has an Exxon credit card may desire to buy a new television. The consumer may request information regarding all purchasing incentives available through AARP and Exxon loyalty programs for the specific television that he or she would like to buy. For example, Exxon may offer a 5% rebate, while the AARP may offer a 10% discount if the consumer is over 65. The consumer may then choose the purchasing incentive with the best deal. This process of receiving a query and identifying purchasing incentives through the consumer’s memberships in existing loyalty programs is fundamentally different from the “contest” format disclosed in Eggleston.

The consumer in Eggleston participates in an incentive program and is able to receive prizes based on his or her performance of a “win eligible” activity for the program, not by simply being a member of the incentive program. A consumer in the Eggleston system may also “query a database that provides status information for the consumer regarding participation in host incentive programs.” Col. 12, lines 58-60. For example, the consumer “can determine the number of points awarded for participation in past incentive programs, the prizes won in past incentive programs, and similar information regarding incentive program activities,” including the “rules and directions” for particular incentive programs. Col. 12, lines 60-66. There is no teaching or suggestion in Eggleston that a consumer can submit a query to identify purchasing incentives for a specific product or service available through the consumer’s loyalty program memberships, or that any information is transmitted identifying purchasing incentives available for that specific product or service. Consequently, the rejections based on Eggleston are clearly erroneous.

III. Eggleston does not teach or suggest verifying that an existing membership is valid.

Independent claims 1, 16, 22, and 23 also recite in various forms “verifying that the consumer’s existing membership in the one or more loyalty programs is valid by comparing the identification information received from the consumer to enrollment information received from the one or more loyalty programs.”

Because no information regarding “existing” memberships is received from the consumer in Eggleston, it would be impossible for the Eggleston system to verify any consumer’s existing membership by comparing information received from the consumer to information received from a loyalty program. As explained above, the host system disclosed in Eggleston recognizes particular incentive programs because the consumer selected and participated in them, not because the consumer provided membership information for them. Eggleston does not teach or suggest the recited verifying step.

IV. Conclusion

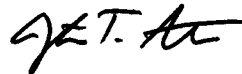
As discussed in detail herein, Eggleston does not teach or suggest (1) receiving information regarding a consumer’s existing memberships in one or more loyalty programs, (2) receiving a query from a consumer for a specific product or service available through the consumer’s membership in one or more loyalty programs and transmitting information identifying available purchasing incentives, and (3) verifying that an existing membership is valid. Further, the rejections and any supporting arguments fail to provide any motivation or rationale why one of ordinary skill in the art would be motivated to extend or alter the system in Eggleston beyond what it discloses. Therefore, because reversal of the pending rejections is likely, Applicant respectfully requests that the cost of appeal be avoided by withdrawing the above rejections.

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Respectfully submitted,

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